

# **In the United States Patent and Trademark Office**

In re the Application of:

Viktors Berstis	)	
Serial Number: 10/755,832	)	Group: 2191
Docket Number: AUS920030667US1	)	Examiner: Phillip H. Nguyen
Filed on: 01/12/2004	)	
For: "System and Method for Automatic	)	
Natural Language Translation During	)	
Information Transfer"	)	

## **APPEAL BRIEF - Revised**

### ***Real Party in Interest per 37 CFR §41.37(c)(1)(i)***

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

### ***Related Appeals and Interferences per 37 CFR §41.37(c)(1)(ii)***

This application is related to U.S. Patent application number 10/455,159, docket number AUS920030289US1, filed on June 5, 2003, by Yen-Fu Chen, now U.S. patent 7,310,781, and to U.S. Patent application number 10/692,173, docket number AUS920030664US1, filed on October 23, 2003, which is still under examination.

### ***Status of Claims per 37 CFR §41.37(c)(1)(iii)***

Claims 1 - 14 are finally rejected. The rejections of Claims 1 - 14 are appealed.

***Status of Amendments after Final Rejections per 37 CFR §41.37(c)(1)(iv)***

The Final Office Action, dated 9/5/2007, cited a secondary reference under 35 U.S.C. §103(a) in a manner which did not enable us to fully respond to the rejections. The patent number was not listed in the PTO search results, or in the Office Action, or captured into PAIR. This secondary reference was referred to only by inventor name in the Office Action.

We attempted to reach the examiner during the shortened statutory to obtain the patent number of the secondary reference. The Examiner was unavailable due to personal vacation. Upon reaching the examiner's supervisor, still during the shortened statutory period for reply, the examiner's supervisor was also unable to determine the necessary identification information for the secondary reference under 35 U.S.C. §103(a).

The examiner's supervisor recommending filing as complete of a reply as possible, but also requesting withdrawal of the finality. On the last day of the shortened statutory period to reply, 12/5/2007, we filed such a reply and amendment according to the recommendations of the examiner's supervisor.

Surprisingly, we received an advisory action from Primary Examiner Steelman refusing to re-set or restart the period of reply, and refusing entry of the amendment on the grounds it raised new issues for examination. Examiner Steelman did, however, provide the needed patent number for the secondary reference under 35 U.S.C. §103(a). Primary Examiner Steelman cited a USPTO policy to deny restarting a period for reply when a missing reference citation is brought to the attention of the USPTO *after* the period for reply has expired, despite the fact that the missing reference was actually brought to the attention of the USPTO *before* the expiration of the shortened period for reply.

We, therefore, rescind and withdraw the previous amendment, and we appeal from the rejections on the basis of errors in examination, both procedural and substantive in nature.

We have submitted with the Notice of Appeal an amendment to cancel Claims 9 - 14 in order to place this application in condition for consideration by the Board of Appeals. We do not yield claims to a system embodiment of the invention, but instead retain the option to file these claims in a subsequent amendment or related patent application. Claims 9 - 14 are presented as "cancelled" for the purposes of arguing in favor of them, should the Examiner refuse entry of the amendment filed concurrent with the Notice of Appeal.

***Summary of the Claimed Subject Matter per 37 CFR §41.37(c)(1)(v)***

The present invention allows a new paradigm in copying and pasting information from one computer file to another in which the user's actions are simplified and streamlined, and in which automatic translation of the copied information from one language to another is provided.

No doubt you are familiar with the typical process of authoring a new document on a computer, such as writing a draft Appeals opinion. You first start by opening the new document in a first window, say for example a word processor window. Then, as you are writing the document, you realize the need to insert some text from another source, such as a citation from an online legal research database. So, you must start a web browser (or switch to a web browser window if it is already running), search for the needed text, highlight it, operate a copy command (e.g. click "Edit" then click "Copy" on drop-down menus, or right-click on the highlighted text and select "copy" for the pop-up menu, etc.). Next, you must switch to the window where you were editing the new document (e.g. back to a word processor window), click where you want to insert the copied text, then operate a paste command (e.g. click "Edit" then click "Paste" on drop-down menus, or right-click at the insertion point and select "paste" for the pop-up menu, etc.).

While this is cumbersome for you to do for a *single* copied or cited text portion, it is even more tiring and tedious if the paper you are writing includes *many copied or cited items*, because the entire process must be repeated for each and every citation added to the new paper.

The inventors have realized that in some situations, a reverse paradigm is much more streamlined and productive. Imagine this process instead -- you need to insert three portions of text from three different sources into one new document (e.g. the new document is the destination for all of your copying). So, you *first* designate the insertion point in the destination document (*destination first*), then you switch to the first source document, highlight text, select "copy" (*source second*), and the text is automatically copied and inserted into the destination document at the designated insertion point *without having to switch back to the window for the new document*. Now, instead of going back to your destination document's window, you simply go to the second *source* window, highlight text, and select "copy", and again, the text is automatically copied for you into the destination document without having to switch back to the destination document. And, again, for the third source, *without having to return to the destination window*. This greatly minimizes the number of tedious actions you have to perform

just to create a document with information from several sources. It creates a sequence of (1) designate the destination insertion point *first*, then (2) designate one or more sources to be copied *second*, which is reverse of the traditional or convention process (source first, destination second).

In an extended usage (e.g. repeated operation), we have created a copying paradigm that allows (1) select insertion point in destination, (2) then select first source information to copy, (3) then select second source information to copy, (4) then select fourth source information, etc., *omitting or eliminating destination steps between source selections*. This is not only reverse of the normal operation, which would be (1) source, (2) destination, (3) source, (4) destination, (5) source, (6) destination, etc., but it omits nearly half of the user's steps (switching back to the destination).

Now, imagine how much more useful this new process would be if it not only performed this reverse-sequence copying for you (e.g. destination-first, source-second sequence), but if the system automatically detected that the source information was not in the language of the destination document, so it automatically would translate the text for you before inserting it. In this way, not only is your editing process streamlined, but it is further enhanced to allow you to quickly combine information from many sources, including international sources such as foreign documents, foreign websites, etc.

Anyone who writes many documents on a computer would easily prefer these improvements over the *status quo*, and this is why we seek patent protection in order to promote commercialization of this useful tool.

To this end, Claim 1 sets forth a method for transferring content from one computer resource to another computer resource, comprising the steps of:

- (a) receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation (*see paragraphs 0066, 0071, and #54 in Fig. 5*);
- (b) subsequent to receiving said command and enablement (*Fig. 5 #54*), receiving a user selection of one or more insertion points (*para. 0070; Fig. 5 #51 - 52*) in the contents of a destination computer resource via a destination user interface, said computer resource consisting of an electronic document;
- (c) subsequent to receiving said user-selected insertion points (*Fig. 5 #52*), receiving

- a user selection of one or more information elements via a source user interface (*para. 0071; Fig. 5 #56*);
- (d) intercepting transfer of said information elements to said destination (*para. 0073, Fig. 5 #501; para. 0098; Fig. 7 #700*);
- (e) determining which intercepted information elements are expressed in a natural language not matching a user-specified natural language (*para. 0073, Fig. 5 #501; para. 0098; Fig. 7 #700*);
- (f) performing one or more natural language handling actions on information said elements which do not match said user specified natural language as defined by one or more natural language handling rules (*para. 0073, Fig. 5 #501; para. 0098; Fig. 7 #700*); and
- (g) transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions (*Fig. 5 #58*).

Likewise, Claim 5 is directed to a computer readable medium encoded with software for transferring content from one computer resource to another computer resource, where the software performs the steps of:

- (a) receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation (*see paragraphs 0066, 0071, and #54 in Fig. 5*);
- (b) subsequent to receiving said command and enablement (*Fig. 5 #54*), receiving a user selection of one or more insertion points (*para. 0070; Fig. 5 #51 - 52*) in the contents of a destination computer resource via a destination user interface, said computer resource consisting of an electronic document;
- (c) subsequent to receiving said user-selected insertion points (*Fig. 5 #52*), receiving a user selection of one or more information elements via a source user interface (*para. 0071; Fig. 5 #56*);
- (d) intercepting transfer of said information elements to said destination (*para. 0073, Fig. 5 #501; para. 0098; Fig. 7 #700*);
- (e) determining which intercepted information elements are expressed in a natural

language not matching a user-specified natural language (*para. 0073, Fig. 5 #501; para. 0098; Fig. 7 #700*);

(f) performing one or more natural language handling actions on information said elements which do not match said user specified natural language as defined by one or more natural language handling rules (*para. 0073, Fig. 5 #501; para. 0098; Fig. 7 #700*); and

(g) transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions (*Fig. 5 #58*).

***Grounds for Rejection For Which Review is Sought per 37 CFR §41.37(c)(1)(vi)***

Relief is requested from:

- (a) objections to the specification under 35 U.S.C. §132(a) regarding introduction of new matter;
- (b) provisional rejections under double patenting doctrine, should the Examiner refuse entry of our terminal disclaimer submitted with our Notice of Appeal;
- (c) erroneous rejections of Claims 1 and 5 under 35 U.S.C. §112, first paragraph;
- (d) erroneous rejections of Claims 9 - 14 under 35 U.S.C. §101, should the Examiner refuse entry of our amendment submitted with our Notice of Appeal; and
- (e) erroneous rejections of Claims 1 - 8 under 35 U.S.C. §103(a) over Miller in view of Mendibil.

*Arguments per 37 CFR §41.37(c)(1)(vii)*

General Remarks Regarding Overall Examination. We respect the role of the U.S. Patent Office as part of the U.S. Department of Commerce as a regulatory body charged not with recognizing clever engineering or design, but charged with the duty to issue exclusive rights to innovators who perpetuate the U.S. economy as a leader in an increasingly global marketplace.

We empathize with the USPTO's role in both trying to promote the useful arts through awarding of patents while simultaneously protecting the public from frivolous or insignificant patents through the application of 35 U.S.C. §102 and 35 U.S.C. §103(a). If we agreed or believed the subject invention to be of such an ordinary nature, we would have foregone the cost and effort to prepare and prosecute the present patent application.

The determination of what an "ordinarily skilled artisan" would have or would not have found obvious to do is difficult at a time contemporary with completion of an invention. The inventors of the invention were present at the time of the invention, and thus represent a witness to what was actually conventional thinking in their art at that time.

The present patent application was first reviewed by an Examiner over three years after its date of filing. While we understand the reasons for the delay, it is also only reasonable to recognize that it must be much more difficult to ascertain what would have been obvious to do three years in the past, and who would have been considered "ordinarily skilled". The faster the rate of change or innovation in a particular technology, the more difficult it must be to make this determination after a considerable time. For this reason, we are appreciative of the effort made by the Examiner under such challenging conditions. We submit that this field of endeavor - user interfaces for editing documents - is a very fast evolving art, driven not only by competitive advances among word processor suppliers and web browser suppliers, but also driven by very innovative GUI techniques on small screens such as web-enabled phones and personal digital assistants. For example, Apple's iPhone, RIM's Blackberry, and Palm's Pilot all have aggressively sought to make their systems easier and more productive to use.

Our invention disclosure has already been made available to the public through pre-grant publication, so as to allow the public to already begin benefitting from our research and development, without compensation to ourselves. And, our useful term for a patent that would issue has been reduced by the pendency period of this application. Even further, the enforceable



scope of our claims has possibly been narrowed through the possibility of prosecution history estoppel.

The Examiner, however, has finalized the decision regarding our patent claims, thereby terminating discourse regarding the cited art and our invention. Whereas the invention remains important to us as a participant in the U.S. economy, we must continue our pursuit of patent protection in order to allow us to realize the necessary gains from our contribution to the technologies in question.

We ask the Administrative Patent Judges to consider both sets of arguments as fairly as possible, whereas erring to the side of rejection of a patent will likely cause irreparable harm to a participant in an economy which is already under intense competition globally. If a trend is realized whereby patent claims are only allowed under the narrowest of terms, then in turn, industry will find ever decreasing value in participating in the patent process. This will, as recognized by the framers of the Constitutional provision regarding patents, lead to the stifling of dissemination of new knowledge, increase in secrecy among innovators, and slow economic progress.

**New Matter Objections under 35 U.S.C. §132(a)**

The Examiner has objected to the specification for adding new matter regarding the addition of the terms "electronic document" and "user enablement of automatic natural language translation". We disagree.

With regards to the term "*electronic document*", we ask you to note our disclosure as originally filed, where it mentions well-known types of computerized documents such as those created with an "*editor program*" (para. 0003), or a *word processor* (paras. 0008, 0011). We have also used synonyms such as "*computer resource*" or "*computer file*" in this context to represent the range of electronic documents on which cut-and-paste operations through an operating system clipboard may be made, such as a database or spreadsheet (para. 0004), and files for contact management utilities, address book, calendar, email client, presentation, financial and bookkeeping programs (para. 0058).

The term "*electronic document*" would be well-understood by a reader of ordinary skill in the art to be referring to these items as exemplified in the disclosure. As evidence of this, the popular, communally-edited website "Wikipedia" actually defines an "electronic document"

consistent with our usage:

Wikipedia: An **electronic document** is any electronic media content (other than computer programs or system files) that are intended to be used in their electronic form, without being printed (although printing is usually possible).

As such, we believe the term "*electronic document*" describes the range of computerized files disclosed and supported by our specification, when given its "plain meaning" as required by USPTO examination procedure and by various Court decisions. (MPEP 2111.01 citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) and *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)).

There is no argument or extrinsic evidence put forth by the Examiner justifying why the term "*electronic document*" would be interpreted by an ordinarily skilled person to mean anything beyond the types of files disclosed in our specification. We believe, therefore, that there is no new matter added by the term.

For these reasons, we submit that the term "*electronic document*" in its ordinary or plain meaning is fully supported by our disclosure, and that no new matter has been introduced. We ask you to set aside these objections for the purposes of reviewing the rejections of the claims.

With respect to the term "*user enablement of automatic natural language translation*", we are referring to a user control to turn off or on (e.g. enable or disable) the automatic function of checking information as it passes through a clipboard for matching a preferred natural language (e.g. "enable highlighting or selecting content to automatically copy selected . . ." in paragraph 0066; "[w]hen all destination points and areas have been designated, the user enables (54) the automatic content transfer function . . ." in paragraph 0071 and Figure 5). An "enablement" is referring to the control being set to the "enabled" condition by the user:

**Enablement** *n.* The act of enabling, or the state of being enabled; ability.  
Source: Webster's Revised Unabridged Dictionary. Retrieved December 03, 2007, from Dictionary.com website: <http://dictionary.reference.com/browse/enablement>

It is difficult to imagine an ordinarily skilled person who is able to combine the Miller and Mendibil references as suggested by the Examiner in the rejections under 35 U.S.C. §103, but who is simultaneously unable to read the term "user enablement" and not recognize the supporting disclosure in paragraphs 0066 and 0071. We believe that the disclosure is sufficiently clear and detailed to support the claim term, and we ask you to set aside these objections for the purposes of reviewing the rejections of the claims.

**Provisional Rejections under Double Patenting Doctrine**

The Examiner has rejected Claims 1 - 14 over co-pending application 10/865,347 under the judicial doctrine prohibiting double patenting. We disagreed in the first Office Action with the Examiner's position, but the Examiner has maintained the rejections in the Final Office Action. In order to place this application in condition for review by the yourselves, the Board of Appeals, we have filed a Terminal Disclaimer under 37 CFR §1.312 with the Notice of Appeal.

Should the Examiner maintain these rejections in the Examiner's Answer, we respectfully request you to reverse these rejections whereas the judicially created doctrine under which this rejection arises is directed towards inappropriate extension of patent terms. A Terminal Disclaimer prevents such inappropriate extension of patent terms.

**Rejections of Claims 1 and 5 under 35 U.S.C. §112, 1<sup>st</sup> ¶**

In the Office Action, new rejections, but final rejections, were made under 35 U.S.C. §112, first paragraph, of Claims 1, 5, and 9. Depending on whether or not the Examiner enters our amendment submitted with our Notice of Appeal, claim 9 may or may not be cancelled. We present arguments for Claim 9, as well as Claims 1 and 5, just in case.

In the rejections, the Examiner has argued that our description, as originally filed, did not contain sufficient subject matter to convey to one ordinarily skilled in the art that we were in possession of the claimed terms "electronic document" and "user enablement of automatic natural language translation". We disagree.

Please refer to our foregoing arguments regarding new matter. The previous arguments are applicable to the rejections under 35 U.S.C. §112, first paragraph.

We believe it is fundamentally inequitable to apply a different standard of "ordinary level of skill in the art" for the purposes of rejections under 35 U.S.C. §112, §132(a), and §103. We

believe that our disclosure, as originally filed, and interpreted using ordinary meanings, as evidenced by our supplied extrinsic evidence, is sufficient to meet 35 U.S.C. §112, first paragraph.

We ask for allowance of Claims 1, 5, and 9.

**Rejections under 35 U.S.C. §101**

We have submitted an amendment with our Notice of Appeal cancelling Claims 9 - 14, but are not sure if it has been entered by the Examiner. So, we present our arguments here against the rejections. Should the Examiner decide to enter our amendment submitted with our Notice of Appeal, the following arguments may be disregarded by the Administrative Patent Judges.

In the first Office Action on the merits, the Examiner rejected claims 1, 5, and 9 - 14 for being directed to non-statutory matter. The Examiner argued that the claims were directed to an abstract idea that is not tied to a technological art, environment or machine that accomplishes a practical application producing a concrete, useful, and tangible result. In particular, the Examiner reasoned:

**Examiner in the Office Action:**

For instance, claim 1 states "determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language" raises a question as to whether the translating step and the transferring step are going to perform when the outcome of the determining step is matched. Since the translating step only performs when there are information elements that do not match the specified natural language. Further more, the transferring step transfers only the translated information.

Regarding claim 9-14, recite a cut-and-paste system but it appears reasonable to interpret this system by one of ordinary skill in the art as software, per se. Applicant's specification provides no explicit and deliberate definition of the components ("information transfer interceptor", "natural language comparator", "natural language handler", and "information element deliver") that make up the system other than they could be software components, which are directed to functional descriptive material, per se, and are therefore non-statutory.

We responded by pointing out that claims 1 and 5 produce information elements having translated natural language in them. By "natural language", the claims are referring to a human

spoken or written language, such as English, Japanese, Spanish, Farsi, etc. (see para. 0037). Such a natural language is "tangible" in that it can be read or heard by a human. By "information elements", the claims are referring to text, tables, graphics, hyperlinks, etc., which are computer readable (see para. 0091). As such, the claimed step:

*" . . . determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language;"*

by definition selects only information elements which are both human readable and computer readable.

Then, the claimed steps:

*" . . . performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions."*

by definition modify those human-readable and computer-readable information elements. There is no disclosure (or claim step) which suggests the modifications in any way remove the human-readable aspects of the information element, only the human readable portion is translated to another human readable format (i.e. from one natural language to another natural language). Therefore, the result or product of the claimed steps is both machine readable and human readable, which is heard or seen through a computer platform's display or speaker (see paras. 0051, 0054, and 0055), and as such, the product of the claims is tangible, useful and concrete.

With respect to the Examiner's statement that *"since the translating step only performs . . . furthermore, the transferring step transfers only the translated information"*, we pointed out that we are only required by to claim the invention, but the claims (taken alone) are required only

to recite enough features, steps, and elements to set forth an operable embodiment with patentably distinctions. The specification is required to teach a preferred embodiment. As such, the Examiner's point that only the translated elements are transferred to the destination is presumably directed to those elements which are not translated - what happens to them?

In one possible embodiment they are transferred unmodified to the destination (see #63 of Fig. 6). But, this step is not claimed in the broadest claims because it is not part of the minimum configuration of the invention (e.g. transferring unmodified information is not new, and simply checking data for compatibility without taking any action or transforming the information element would not seem to meet the requirements of §101).

With respect to the argument that claims 9 - 14 could be interpreted by one of ordinary skill as software, per se, and that our specification provides no explicit and deliberate definition of the system components recited in this claim, we respectfully disagreed. We pointed out that by "system", we are referring to a combination of software and hardware, or even an embodiment purely in hardware (e.g. electronic circuitry and mechanical devices). Such a "system" was thoroughly described, including many recitations of circuitry and hardware components, in the "suitable computing platform" portion of the detailed description (see paras. 0044 - 0064). And, logical processes were described in an interchangeable manner as method steps or "system functions" in alternative embodiments (see paras. 0002 - 0004, 0069).

More specifically, we stated at the outset of the description of the "logical processes" that (see para. 0065):

*"It will be readily recognized by those skilled in the art that the following methods and processes may be alternatively realized as hardware functions, in part or in whole, without departing from the spirit and scope of the invention."*

As such, we argued that one of ordinary skill in the art, equipped with both the claims and the complete specification, would readily recognize that an *"an information transfer interceptor configured to intercept one or more information elements in transit from a source to a destination via a transfer buffer . . ."* claims a system component corresponding to the logical process described as *"intercepting one or more information elements"*. The same ordinarily

skilled person would also recognize such a system component could be realized in custom circuitry, such as an Application Specific Integrated Circuit ("ASIC"), a programmed processor, etc.

Further, the recitation of the claim as a "system" in the context of an invention described for embodiment in conjunction with a "suitable computer platform" invokes the ordinary definition which necessarily includes more than just software:

**system** - noun

...

15.     **Computers.** a working combination of hardware, software, and data communications devices.

...

Source: "system." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 05 Jun. 2007.

<Dictionary.com <http://dictionary.reference.com/browse/system>>

In the second Office Action, the Examiner did not mention the rejections of Claims 1 and 5 under 35 U.S.C. §101, so we presume these rejections were withdrawn.

In the second Office Action, the Examiner does repeat and maintain the rejections of claims 9 - 14 under 35 U.S.C. §101. The Examiner has agreed that our specification describes an embodiment which includes at least some hardware, but has held that the claims do not contain any hardware components such as CPU, ROM, RAM, etc., to carry out the recited steps.

We respectfully disagree. We believe the plain meanings of certain claim terms have not been properly used in determining the scope of the claims. Of course, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). However, this means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

While limitations cannot be read into the claims from the disclosure, neither can the Examiner interpret the claims in a manner inconsistent with our disclosure because the claims are part of the disclosure, and because the claims would be interpreted by one of ordinary skill in the art in the context of our disclosure.

35 U.S.C. 112:

. . . The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.. . .

Federal Circuit regarding Interpretation of Claim Terms in view of Inventor's Disclosure:

"Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification."

. . .

"For that reason, claims must be read in view of the specification, of which they are part . . . [T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term . . . "

"Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. . . . In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as express in the specification, is regarded as dispositive." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc).

We believe that final rejections of claims 9 - 14 are erroneous because they depend on an argument that a "system" can be purely software, devoid of any hardware components or any device to perform the steps of the claims. We have provided extrinsic evidence in the form of dictionary definitions which show the ordinary meaning of the term "system" includes some hardware components. The Examiner has provided no extrinsic evidence to the contrary, nor has an affidavit from the Examiner to the contrary, been entered on the record.



Additional extrinsic definitions, and indeed previous Court decisions, support our ordinary meaning of the term "system":

"The computer itself is the 'hardware'; the programming necessary to run it is the 'software'; together the hardware and software form the 'computer system.'" *Computer Systems Eng'g, Inc. v. Qantel Corp.*, 740 F.2d 59, 63 n.3 (1st Cir. 1984).

A computer system "... consists of a central processing unit (or 'mainframe') and peripheral equipment." *Greyhound Computer Corp. v. IBM Corp.*, 559 F.2d 488, 492 (9th Cir. 1977).

A computer system is a "group of devices designed: (a) to receive various forms of data (input); (b) to process the data in accordance with predesignated sets of instructions (programs); and (c) to produce the desired information (output)." *Dreier Co. v. Unitronix Corp.*, 218 N.J. Super. 260, 527 A.2d 875, 879 (1986).

For these reasons, we believe that Claims 9 - 14 do not only recite software, *per se*, but instead are directed towards statutory subject matter, necessarily include "hardware", and produce a tangible, concrete, and useful result. We believe an error in examination has occurred by affording non-ordinary meaning to the term "system", and by failing to consider our claims in light of our specification.

We respectfully request allowance of Claims 9 -14 if the Examiner refuses entry of our amendment submitted with our Notice of Appeal.

**Rejections under 35 U.S.C. §103(a) over Miller in view of Mendibil.**

The rejections of Claims 1 and 5 over Miller's "Synchronized Clipboards of Multiple Computers" in view of Mendibil's US Patent 5,426,583 is erroneous because:

(1) Miller fails to teach our reverse-order method of first designating an insertion point followed by designating or selecting the source information; and

(2) There is no indication by Miller or Mendibil that the problem addressed by the invention was recognized by those in the art at the time of the invention;

(3) There is no linking suggestion in either Miller or Mendibil to suggest one of ordinary

skill in the art would have been motivated to make the proposed changes without recognizing the problem disclosed by the inventors.

We ask you to note that this is our first opportunity to respond to these grounds of rejections as they are first raised by the Examiner in an action which is also made Final.

Error #1: Overlooking and Entire Step of the Claims. We request that you to note a first error in the rationale for the rejections regarding our claim step of:

" receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation; . . . "
--

As the cited references must teach all of the claim steps, elements, and limitations, the rejection is erroneous for omitting an entire step in the rationale for the rejections. This step is supported by our disclosure, which is discussed in more detail later in this Appeal Brief. But, for the purposes of considering the rejections under 35 U.S.C. §103(a), it is suffice to recognize that there is no rationale presented regarding this step, which we respectfully submit is a considerable error in examination. 37 C.F.R. §1.104(a)(1) and (a)(2). Without examining every claim element, and without notifying an application of the reasons for rejection of every claim element, an applicant is unfairly denied the opportunity to respond through amendment, argument, or both amendment and argument.

Error #2: Overlooking "Subsequent" Limitations in the Claims. Our claims not only present a set of steps, but a set of steps in a certain sequence or order, as indicated by the limitations expressed by the term "*subsequent to* <earlier action>, <later action>". The Court has repeatedly emphasized that such order of steps must be anticipated by the art, especially if explicitly stated in the language of the claims, and even sometimes when it is apparent for the disclosure that the order is significant to the claim. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 65 USPQ2d 1865, 1869 (Fed. Cir. 2003). *Interactive Gift Express, Inc., v. CompuServe Inc.*, 256 F.3d 1323, 59 USPQ2d 1401 (Fed. Cir. 2000). *Loral Fairchild Corp. v. Sony Electronics Corp.*, 181 F.3d 1313, 1321, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999). *Mantech Evtntl. Corp. v. Hudson Evtntl. Servs., Inc.*, 152 F.3d 1368, 1375 - 76, 47 USPQ2d 1732, 1739 (Fed. Cir. 1998).

We agree that Miller teaches a cut-and-paste operation, but we believe Miller fails to teach the *destination-first, source-second* sequence we have claimed. We also find that Miller does not recognize the problem our method solves or the advantages of our approach. We find, instead, that Miller's process is the typical *source-first, destination second* process, known so well on other user interfaces:

Miller, first column, third paragraph:

". . . select an item on one computer, copy it to the clipboard (using the standard Copy command available in most applications), then turn to the other computer and paste the item (using the standard Paste command)."

For this reason, we find that Miller fails to teach all of the claim steps, elements and limitations related to designating a destination point *before* selecting the source information to be copied.

We agree with the Examiner that Miller also fails to disclose many other claim elements:

Examiner in the Office Action:

Miller does not explicitly disclose:

- determining which intercepted information elements are expressed in a natural language not matching a user-specified natural language;
- performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and
- transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.

We find that Mendibil is not a cut-and-paste type of technology at all, instead being limited to language translation in general. As such, we ask you to note that it has no disclosure whatsoever relating to copying text from one program or another, so Mendibil fails to teach our destination-first, source-second method of copying information from one computer resource to another.

Error #3: Claim Limitation of Intercepting Copied Information Not Found. We believe that Examiner has erroneously reasoned that Miller's interception of information elements on a

PalmPilot and redirecting them to a PC anticipates our claim term regarding intercepting information in a clipboard so that it can be determined if it needs to be translated. Miller's "interception" is for the purposes of redirecting the data from one computer to a second computer, which is not the same as our interception of information for potential translation of it and then transfer of it (or its translated equivalent) to another program. While we agree that both intercept information at the clipboard, one must set aside the rest of our claim limitations in order to draw a conclusion of anticipation.

The Federal Circuit has indicated that the claims must be considered as a whole, beyond analysis of only the differences between the individual claim components and multiple references:

[Although *Graham v. John Deere Co.*, 383 U.S. at 17, 148 USPQ at 476, requires that certain factual inquiries, among them the differences between the prior art and the claimed invention, be conducted to support a determination of the issue of obviousness, the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1033 (Fed. Cir. 1984) (emphasis added). See also *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 225 USPQ 26, 31 (Fed. Cir. 1985)

And:

It is impermissible to use the claimed invention, as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The Examiner has stated that Mendibil teaches translation of information, but he has not established where Miller or Mendibil suggest that the clipboard should or could be used as the link between the copy-and-paste function and a translator. While Mendibil mentions many types of systems which may benefit from their translator (col. 5, lines 13 - 31), Mendibil is silent

regarding interfacing to a clipboard or clipboard content interceptor.

For these reasons, we believe it was erroneous for the Examiner to hold that Miller in view of Mendibil renders claims 1 - 8 obvious under 35 U.S.C. §103(a). We request reversal of these rejections.

For all of these reasons, we request reversal of all rejections as being erroneous.

Respectfully,

*/ Robert Frantz /*

Robert H. Frantz, Reg. No. 42,553

Tel: (405) 812-5613

Franklin Gray Patents, LLC

Franklin Gray Patents, LLC

P.O. Box 23324

Oklahoma City, OK 73127

Tel: 405-812-5613

Fax: 405-440-2465

**Claims Appendix**  
*per 37 CFR §41.37(c)(1)(viii)*  
**Clean Form of Claims**

1. (previously presented) A method for transferring content from one computer resource to another computer resource, comprising the steps of:
  - receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation;
  - subsequent to receiving said command and enablement, receiving a user selection of one or more insertion points in the contents of a destination computer resource via a destination user interface, said computer resource consisting of an electronic document;
  - subsequent to receiving said user-selected insertion points, receiving a user selection of one or more information elements via a source user interface;
  - intercepting transfer of said information elements to said destination;
  - determining which intercepted information elements are expressed in a natural language not matching a user-specified natural language;
  - performing one or more natural language handling actions on information said elements which do not match said user specified natural language as defined by one or more natural language handling rules; and
  - transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.
2. (original) The method as set forth in Claim 1 wherein said handling actions comprise isolating certain information elements according to said handling rules, thereby blocking their transfer to said destination.
3. (original) The method as set forth in Claim 1 wherein said handling actions comprise determining an original natural language in which each intercepted information elements is expressed, and subsequently invoking a computer translation process to translate each item from said original natural language to said user-specified natural language.

4. (original) The method as set forth in Claim 1 further comprising the steps of:
  - invoking a rule management user interface responsive to finding no existing natural language handling rule for an information element to be transferred; and
  - allowing, via said rule management user interface, a user to define an action to be taken selected from the list of invoking a natural language translation process, allowing transfer without modification, and isolating said information element.
5. (previously presented) A computer readable medium encoded with software for transferring content from one computer resource to another computer resource, said software performing the steps of:
  - receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation;
  - subsequent to receiving said command and enablement, receiving a user selection of one or more insertion points in the contents of a destination computer resource via a destination user interface, said computer resource consisting of an electronic document;
  - subsequent to receiving said user-selected insertion points, receiving a user selection of one or more information elements via a source user interface;
  - intercepting transfer of said information elements to said destination;
  - determining which intercepted information elements are expressed in a natural language not matching a user-specified natural language;
  - performing one or more natural language handling actions on said information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and
  - transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.

6. (original) The computer readable medium as set forth in Claim 5 wherein said software for performing natural language handling actions comprises software for isolating certain information elements according to said handling rules, thereby blocking their transfer to said destination.
7. (original) The computer readable medium as set forth in Claim 5 wherein said software for performing natural language handling actions comprises software for determining an original natural language in which each intercepted information elements is expressed, and for subsequently invoking a computer translation process to translate each item from said original natural language to said user-specified natural language.
8. (original) The computer readable medium as set forth in Claim 5 further comprising software for performing the steps of:
  - invoking a rule management user interface responsive to finding no existing natural language handling rule for an information element to be transferred; and
  - allowing, via said rule management user interface, a user to define an action to be taken selected from the list of invoking a natural language translation process, allowing transfer without modification, and isolating said information element.



9. (cancelled) A cut-and-paste system for transferring content from one computer resource to another computer resource, comprising:
  - a command received from a user to enable automatic cutting-and-pasting in a destination first, source second sequence, with a user enablement of automatic natural language translation;
  - a user destination selection received subsequent to said command, said source selection including one or more insertion points in the contents of a destination computer resource via a destination user interface, said computer resource consisting of an electronic document;
  - a user source selection, received subsequent user-selected destinations, said source selection including one or more information elements via a source user interface;
  - intercepting transfer of said information elements to said destination;
  - an information transfer interceptor configured to intercept said information elements in transit from said source computer resource to said destination computer resource via a transfer buffer;
  - a natural language comparator configured to identify which intercepted information elements are not originally expressed in a natural language which matches a user-specified natural language;
  - a natural language handler which performs one or more natural handling actions on said identified information elements as defined by one or more handling rules; and
  - an information element deliverer configured to transfer information elements to said destination as defined by one or more handling rules.
10. (cancelled) The system as set forth in Claim 9 wherein said handler is further configured to isolate certain information elements according to said handling rules, thereby blocking their transfer to said destination, and where said cut-and-paste system further comprises an isolation data store for receiving and storing said isolated information elements.

11. (cancelled) The system as set forth in Claim 9 wherein said handler is further configured to determine an original natural language in which each intercepted information elements is expressed, and to subsequently invoke a computer translation process to translate each item from said original natural language to said user-specified natural language.
12. (cancelled) The system as set forth in Claim 9 further comprising a rule management user interface configured to allow a user to define an actions to be taken on designated types of information elements, including at least one action selected from the group of creation of new handling rule, deleting a handling rule, copying a handling rule, and modifying a handling rule.
13. (cancelled) The system as set forth in Claim 12 wherein said rule management user interface is manually invoked by said user.
14. (cancelled) The system as set forth in Claim 12 wherein said rule management user interface is automatically invoked responsive to finding no existing natural language handling rule for an intercepted information element.

**Evidence Appendix**  
*per 37 CFR §41.37(c)(1)(ix)*

No evidence has been submitted by applicant or examiner pursuant to 37 CFR §§1.130, 1.131, or 1.132.

**Related Proceedings Appendix*****per 37 CFR §41.37(c)(1)(x)***

No decisions have been rendered by a court or the Board in the related proceedings as identified under 37 CFR §41.37(c)(1)(ii).